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P. 1

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PATENT
CUSTOMER NUMBER, 34,986
Docket No. 01064-0011-08-000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
Richard LEVY)
Serial No.: 10/614,114) Group Art Unit: 1774
Filed: July 7, 2003)
For: SUPERABSORBENT POLYMER) Examiner: Jill Gray
COMPOSITIONS ON A)
SUBSTRATE (AS AMENDED))

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

APPELLANT'S BRIEF ON APPEAL PURSUANT TO 37 C.F.R. § 41.37

Appellant submits the following brief to perfect the appeal filed on October 5, 2005 in response to the second non-final rejection of this application. The brief sets forth the authorities and arguments on which appellant will rely to maintain the appeal. Appellant encloses PTO Form 2038 for payment of the \$250.00 fee (small entity) pursuant to 37 C.F.R. § 41.20(b) (2) for filing this brief and the \$225.00 fee (small entity) for a two-month extension of time pursuant to 37 C.F.R. § 1.17(a) (2).

(i) **Real Party In Interest**

02/03/2006 MBINAS 00000004 10614114
01 FC:2402 250.00 OP

The inventor assigned the parent application Serial No. 08/487,436, filed June 7, 1995 to Lee County Mosquito Control District. The assignment was recorded at reel 7878, frame 0620 on

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August 23, 1995, which makes Lee County Mosquito Control District the real party in interest.

(ii) Related Appeals and Interferences

Appellant has the following pending appeals before the Board of Patent Appeals and Interferences in applications which may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Serial No. 10/614,114 Filed July 7, 2003

Filed July 7, 2003

Serial No. 08/943,125 Filed October 3, 1997

The Patent and Trademark Office (PTO) has labeled the cover of their file for application Serial No. 08/943,125 as follows:

U. S. PATENT AND TRADEMARK OFFICE
RETURN TO (PTO 1056)
INTERFERENCE SERVICE BRANCH
This case is involved in an
Interference Proceeding

Appellant attaches a copy of the August 12, 2002 certified interference notice as placed on the PTO file jacket of application Serial No. 08/943,125. The Patent and Trademark Office has not notified appellant that they have declared an interference in any of the foregoing applications, even though they indicated on the file of application Serial No. 08/943,125 "[t] his case is involved in an Interference Proceeding." The Board also advised, when contacted by

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appellant's attorneys by telephone, that the Patent Office had not declared an interference in application Serial No. 08/943,125.

(iii) Status of Claims

As of September 1, 2005, when appellant responded to the examiner's July 19, 2005 non-final rejection, the application contained claims 57-63, 65-71, 73, 76, and 87-91. Appellant had cancelled claims 1-56, 64, 72, 74-75, and 77-86 without prejudice or disclaimer during the prosecution of the application.

(iv) Status of Amendments

The examiner has not considered appellant's September 1 amendment to claims 57, and 65, or new claim 91.

(v) Summary of Claimed Subject Matter

The invention comprises a substrate coated with a substantially water free composition (written description, page 20, paragraph bridging pages 31-32) comprising a superabsorbent polymer that absorbs greater than about 100 times its weight in water (written description, paragraph bridging pages 22-23) with a material for decreasing friction between moving surfaces where the material is a lubricating metal, and alloy thereof, lubricating metal chalcogenide, halide, carbonate, silicate, phosphate, or a particulate lubricating metal nitride, carbon lubricant, silicate ester, polyphenyl ether, organic phosphate; biphenyl, phenanthrene or phthalocyanine compound, optionally containing a lubricant comprising an organic lubricant, inorganic lubricant or a lubricant additive; or mixtures thereof. The written description supports

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the organic lubricants at pages 6-14 and the paragraph bridging pages 25-26, whereas pages 15-18 support inorganic lubricants, additives at page 25, first full paragraph, lubricant additives specifically at pages 7-10, and mixtures at page 26, second full paragraph *inter alia*. In addition, original claims 6, 10, and 14 also support the amendments to the claims that describe the material for lubricating a surface. Page 39, last sentence describe the composition as useful for protecting substrates from the "affects of water or water migration."

(vi) **Grounds of Rejection to be Reviewed on Appeal**

- a. Whether claims 62-63 and 70-71 allegedly fail to comply with the requirement under 35 U.S.C. § 112, first paragraph that the written description convey to a person with ordinary skill in the art that the inventor, at the time he filed the application, was in possession of the invention comprising the coating applied to a substrate comprising a cable or a wire?
- b. Whether claims 57-63, 65-71, 73, 76, and 87-90 are obvious under 35 U.S.C. § 103 (a) and therefore unpatentable in view Freeman, United States Patent No. 5,218,011 or Marciano-Agostinelli et al., United States Patent No. 5,049,593 (Marciano-Agostinelli) or Freeman in view of Marciano-Agostinelli?

(vii) **Argument**

The Rejection under 35 U.S.C. § 112 First Paragraph and Traverse

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The examiner rejects claims 62-63 and 70-71 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the requirement that the written description convey to a person with ordinary skill in the art that the inventor was in possession of the invention comprising the coating applied to a substrate comprising a cable or a wire at the time he filed the application. The examiner argues that the application does not describe the substrate as a cable or a wire. Appellant traverses the rejection for the following reasons.

As to the coated wire, or coated cable, pages 6-19 of the written description describe the various lubricants used in combination with the superabsorbent polymer which include petroleum lubricants, synthetic lubricants, grease, solid lubricants and metal working lubricants. Importantly, page 20 of the written description states that appellant's lubricant composition comprises a superabsorbent polymer in combination with lubricants described in the written description that include those described at pages 6-19.

One of the lubricants described at pages 6-19 include the lubricants noted on page 12 comprises cable lubricants. (written description, page 12, line 6 from the bottom). The application therefore supports the claims directed to the lubricant of the invention on a substrate comprising a cable.

Furthermore, one of the lubricants described at pages 6-19 of the written description includes a lubricant applied to a wire substrate (page 16, line 8 from the bottom, page 17, line 5 and page 47, line 8 from the bottom). The application therefore supports claims directed to the lubricant of the invention on a substrate where the substrate comprises a wire. The examples also specifically show the composition of the present invention on a wire substrate at page 51,

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first full paragraph, page 52, first and second paragraphs, page 53, line 3, and page 54, first and second full paragraphs by illustrating the use of a wire whip to manufacture the compositions.

The foregoing clearly shows the superabsorbent polymer/lubricant composition coated on a cable or a wire substrate does not comprise new matter. The appellant clearly had possession of this aspect of the invention at the time he filed the application.

The Rejection under 35 U.S.C. § 103 (a) and Traverse

The examiner rejects claims 57-63, 65-71, 73, 76, and 87-90 under 35 U.S.C. § 103 (a) as unpatentable over Freeman, United States Patent No. 5,218,011 or Marciano-Agostinelli et al., United States Patent No. 5,049,593 (Marciano-Agostinelli) or Freeman in view of Marciano-Agostinelli . Appellant traverses the rejection for the following reasons.

Appellant distinguishes both Freeman and Marciano-Agostinelli because the references, taken either alone or in combination with one another, neither teach nor suggest appellant's essentially water-free composition, wherein the composition comprises a superabsorbent polymer that absorbs greater than 100 times its weight in water in combination with a material for lubricating a surface wherein the material for lubricating a surface comprises:

(1) a lubricating metal and alloy thereof, lubricating metal oxide, halide, carbonate, silicate, or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or

(2) a silicate ester, polyphenyl ether, phosphate, biphenyl, phenanthrene, or phthalocyanine;

the material for lubricating a surface optionally comprising an organic lubricant, inorganic lubricant, or a lubricant additive;

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or mixtures thereof.

Freeman describes superabsorbent polymers at column 7, lines 21 et seq., lines 29 et seq. and Lines 17 et seq., and the following lubricants at column 7, lines 20 et seq.:

silicones,
petroleum oils,
high viscosity esters,
polyglycols,
olefins,
fluorocarbons,
mixtures of;
polyalkylen glycols,
poly alpha-olefins,
polyisobutylene; and
mineral oils.

Appellant, however, claims inorganic lubricants, and none of these material comprise the inorganic lubricants claimed according to the present invention.

Lastly, Freeman does not disclose the water absorbency of the polymer he employs. Appellant's polymer has to absorb at least 100 times its weight in water, but Freeman does not teach this water absorbency. Freeman's water absorbency could be only about 40 or 50, but the skilled artisan can make no determination of what the patentee required by way of water absorbency since the reference doesn't say anything in this regard. The examiner cannot pluck appellant's water absorbency out of Marciano-Agostinelli since, as appellant will show, Marciano-Agostinelli does not contain the requisite teaching or suggestion to combine its teachings with Freeman.

Marciano-Agostinelli teaches a composition consisting of a mixture (column 3, lines 34 et

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seq.) of a superabsorbent polymer (column 53, lines 26 et seq.) and a "rubber" (column 5, lines 3 et seq.). Appellant does not employ "rubber" as a lubricant, and importantly none of the references relied on by the examiner teach or suggest that "rubber" comprises a material for lubricating a surface. Marciano-Agostinelli therefore, standing alone, does not make appellant's invention obvious.

Furthermore, Marciano-Agostinelli, or the combination of Freeman with Marciano-Agostinelli teaches away from appellant's invention, since the examiner has not shown where the prior art teaches or suggests the use of "rubber" as a lubricant. The references individually, or taken together therefore contain no motivation for combining their teachings. Combing Freeman with Marciano-Agostinelli would produce a composition consisting of the Marciano-Agostinelli "rubber" admixed with the Freeman lubricants which is not the appellant's invention. Appellant does not employ "rubber" as a lubricant. The references combined teachings would not produce appellant's composition since the resulting composition would have to contain "rubber."

As to motivation to combine Freeman with Marciano-Agostinelli, the Examiner "has to point to some teaching, [or] suggestion. . . in the prior art to select and combine the references that . . . [she] relied on to show obviousness." In re Lee, 227 F.3d 1338, 61 U.S.P.Q. 1430, 34 (Fed. Cir., 2002) (emphasis added). "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to select and combine the references relied on as evidence of obviousness...the central question is whether there is a reason to combine references." Lee, 61 U.S.P.Q. at 1435 (emphasis added) (citation omitted). Appellant submits that the Examiner has not pointed to anything in the cited references that

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would lead a person with ordinary skill in the art to combine their teachings.

The combination of references does not make appellant's invention obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01 citing In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2nd 1430 (Fed. Cir. 1990). Also, there must be some reasonable expectation of success (M.P.E.P. § 2143.02, citing In re Merck & Co., Inc. 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986)) and that some advantage or expected beneficial result would have been produced by their combination. (M.P.E.P. § 2144 citing In re Sernaker, 702 F.2d, 989, 994-95, 217 U.S.P.Q. 1, 5-6 (Fed. Cir. 1983)). Lastly, the prior art references must teach or suggest all of the appellant's claim limitations. (M.P.E.P. §§ 2143 and 2143.03, and In re Royka, 490 F. 2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974) cited in M.P.E.P. § 2143.03.)

In summary, there is no teaching, suggestion or motivation in the prior art to use "rubber" in a lubricating material; the prior art does not include evidence relevant to select and combine the references, especially where common experience teaches rubber has just the opposite properties of a lubricant, i. e., there is no reason to combine the references because the examiner has not shown that "rubber" acts as a lubricant; the prior art does not show or suggest the desirability of the combination or reasonable expectation of success when using "rubber" in a composition for lubricating a surface; and that some advantage or expected beneficial result would have been produced by using "rubber" in a composition for lubricating a surface.

Freeman does not teach all of the limitations of the invention since the patentee does not disclose or suggest using a superabsorbent polymer that absorbs greater than 100 times its weight in water. Freeman's superabsorbent polymers, for example may be limited to compounds that only absorb 20-40 times their weight in water. In any event the reference does

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not inform the skilled artisan of the water absorbency, and as such fails to meet the test of obviousness by not disclosing all of the limitations of appellant's claims. The examiner cannot combine Marciano-Agostinelli with Freeman to obtain appellant's water absorbency since Marciano-Agostinelli's use of "rubber" clearly prevents the combination of teachings.

Similarly Marciano-Agostinelli does not teach all of the appellant's claim limitations and therefore is not a reference applicable in the examiner's obviousness rejection since Marciano-Agostinelli does not teach or suggest appellant's lubricants, but rather "rubber" combined with a superabsorbent polymer.

Additionally, Freeman and Marciano-Agostinelli, either taken alone or in combination with one another neither teach nor suggest the appellant's substrate coated with the presently claimed composition, or a method for protecting a substrate from the affects of water or water migration by employing the presently claimed composition.

Conclusions

Appellant requests the Board to reverse the examiner in all respects and remand the application to the examiner for the issuance of a Notice of Allowance.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

Dated: February 2, 2006

By: /Robert J. Eichelburg, Reg. No 23,057/
Robert J. Eichelburg

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(viii) Claims appendix

Claims 1-56 (canceled without prejudice or disclaimer).

57: A substrate coated with an essentially water-free composition, wherein said composition comprises a superabsorbent polymer that absorbs greater than 100 times its weight in water in combination with a material for lubricating a surface wherein said material for lubricating a surface comprises:

- (1) a lubricating metal and alloy thereof, lubricating metal chalcogenide, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or
- (2) a silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound;
- (3) said material for lubricating a surface optionally containing a lubricant comprising an organic lubricant, inorganic lubricant, or a lubricant additive;
- (4) or mixtures thereof.

58: The substrate of claim 57 wherein said organic lubricant comprises a petroleum lubricant, synthetic lubricant, grease, or solid lubricant, or combinations thereof and wherein said additive comprises a detergent or a dispersant.

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59: The substrate of claim 57 wherein said superabsorbent polymer is neutralized or cross-linked, and is based on acrylic acid, acrylamide, or an acrylate.

60: The substrate of claim 58 wherein said superabsorbent polymer is neutralized or cross-linked, and is based on acrylic acid, acrylamide, or an acrylate.

61: The substrate of claim 57 wherein said organic lubricant comprises a petroleum oil, an organic ester, a silicone, or a glycol, or combinations thereof.

62: The substrate of claim 57 wherein said substrate comprises a cable.

63: The substrate of claim 57 wherein said substrate comprises a wire.

64 (canceled without prejudice or disclaimer).

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65: A method of protecting a substrate from the affects of water or water migration comprising coating said substrate with an essentially water-free composition, wherein said composition comprises a superabsorbent polymer that absorbs greater than 100 times its weight in water in combination with a material for lubricating a surface wherein said material for lubricating a surface comprises:

- (1) a lubricating metal and alloy thereof, lubricating metal chalcogenide, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or
- (2) a silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound;
- (3) said material for lubricating a surface optionally containing a lubricant comprising an organic lubricant, inorganic lubricant, or a lubricant additive;
- (4) or mixtures thereof.

66: The method of claim 65 wherein said organic lubricant comprises a petroleum lubricant, synthetic lubricant, grease, or solid lubricant, or combinations thereof, and said additive comprises a detergent or a dispersant.

67: The method of claim 65 wherein said superabsorbent polymer is neutralized or cross-linked, and is based on acrylic acid, acrylamide, or an acrylate.

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68: The method of claim 66 wherein said superabsorbent polymer is neutralized or cross-linked, and is based on acrylic acid, acrylamide, or an acrylate.

69: The method of claim 65 wherein said organic lubricant comprises a petroleum oil, an organic ester, a silicone, or a glycol, and combinations thereof.

70: The method of claim 65 wherein said substrate comprises a cable.

71: The method of claim 65 wherein said substrate comprises a wire.

72 (canceled without prejudice or disclaimer).

73: The substrate of claim 57 wherein the particle size of the superabsorbent polymer comprises from about less than 0.5 microns to about 300 microns.

Claims 74-75 (canceled without prejudice or disclaimer).

76: The method of claim 65 wherein the particle size of the superabsorbent polymer comprises from about less than 0.5 microns to about 300 microns.

Claims 77-86 (canceled without prejudice or disclaimer).

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87: The substrate of any one of claims 57-63 and 73 wherein said composition is a product produced by the process of combining said superabsorbent polymer with said material for lubricating a surface.

88: The method of any one of claims 65-71 and 76 wherein said composition is a product produced by the process of combining said superabsorbent polymer with said material for lubricating a surface.

89: The substrate of one of claims 57-63 and 73 wherein said composition protects said substrate from the affects of water or water migration.

90: The substrate of claim 87 wherein said composition protects said substrate from the affects of water or water migration.

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91: The substrate of one of claims 57 or 65 wherein said :

(1) lubricating metal and alloy thereof, lubricating metal chalcogenide halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant surface comprises;

molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, cadmium oxide, borax, basic white lead, lead carbonate, lead monoxide, lead iodide, asbestos, talc, mica, zinc oxide, zinc phosphate, iron phosphate, manganese phosphate, carbon, graphite, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, or the Group VIII noble metals or mixtures thereof.

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(ix) Evidence appendix

Appellant did not present any evidence to the examiner in the prosecution of this application, but at this time attaches a photocopy of the first two pages of the August 12, 2002 certified interference notice as placed on the PTO file jacket of application Serial No. 08/943,125.

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DN 204278

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

**UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office**

August 21, 2000

**THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE
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SERIAL NUMBER: 08/943,125

FILING DATE: October 03, 1997

**By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS**

L. Edele
L. EDELEN
Certifying Officer

Utility Model Serial Number						Patent Date		Patent Number		
Serial Number 08/943,126		Filing Date 10/03/97		Class 252		Subclass 508		Group Art Unit 1111		
Applicants RICHARD LEVY, MYERS, FL.						Examiner medley				
CONTINUING DATA* VERIFIED THIS APPLN IS A CON OF 08/487,436 06/07/95 <i>Mem</i>										
FOREIGN/PCT APPLICATIONS* VERIFIED <i>Mem</i>										
CPA										
Foreign Filing License Granted 11/1/97										
Small Entity Status										
Foreign priority claimed 35 USC 119 conditions met		<input type="checkbox"/> yes <input checked="" type="checkbox"/> no								
Verified and Acknowledged		Examiner's Initials	AS FILED	STATE OR COUNTRY FL	SHEETS DRAWINGS 0	TOTAL CLAIMS 11	INDEP. CLAIMS 1	FILING FEE RECEIVED \$395.00	ATTORNEY'S DOCKET NO. 1084-9811-6	
ADDRESS FINNEGAN HENDERSON FARABOW GARRETT AND DUNNER 1300 I STREET NW WASHINGTON DC 20005-3316										
TITLE LUBRICANT COMPOSITIONS AND METHODS										
U.S. DEPT. OF COMM./PAT. & TM—PTO-436 (Rev.12-84)										
PARTS OF APPLICATION FILED SEPARATELY										
NOTICE OF ALLOWANCE MAILED										
ISSUE FEE										
Amount Due	Date Paid									
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(x) Related proceedings appendix

The Board of Appeals scheduled an oral hearing for the afternoon of January 25, 2006 in the appeal of related application Serial No. 08/943,125 Filed October 3, 1997, however, advised appellant's attorney by telephone on the morning of January 25, before they heard oral argument, that upon reviewing appellant's brief they overruled the rejection in all respects and would remand the case to the examiner. Appellant's attorney, as of the filing of this brief, has not received the written decision of the Board in this regard.

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CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that this correspondence is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, facsimile telephone number (571) 273-8300 on the date indicated below.

By: Robert J. Eichelburg, Reg. No. 23,057/
Robert J. Eichelburg

Dated: February 2, 2006